

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed June 2, 2005. Applicant amends Claim 78 without prejudice or disclaimer to address a minor clerical error. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Allowable Subject Matter

Applicant notes with appreciation the Examiner's allowance of Claims 34-35, 72-73, 98-99, 123-124, and 150-151 and the Examiner's indication that the subject matter of these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (See Pending Office Action, p. 21). Applicant reserves the right to comment on the appropriateness of the allowed subject matter designation at a future time, should Applicant deem it appropriate to do so.

Section 112 Rejection

The Examiner rejects Claims 78 and 81 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended Claim 78 in order to address the Examiner's concern.

Section 102 Rejection

The Examiner rejects Claims 1, 4, 6-11, 13-17, 19-20, 38-40, 42-49, 51-55, 57-58, 76-78, 80-89, 94, 100-109, 127-136, 154-159, and 161-168, as far as Claim 78 is definite, under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,285,777 issued to Kanevsky et al. (hereinafter "*Kanevsky*").

As an initial matter, Applicant is buoyed by the Examiner's recognition of the deficiencies of *Sansone*, as *Sansone* does not provide an appropriate basis for the previously posited §102 rejection. Applicant is optimistic that, in a similar fashion, the Examiner can be shown the disparate teachings of *Kanevsky* when juxtaposed with the subject matter outlined by the pending claims. Applicant fully understands the Examiner's current position and contention and, after reading *Kanevsky* in its entirety, is confident that a mutually agreeable resolution can be reached with respect to the pending subject matter.

Independent Claim 1 recites:

1. A method for routing an object in a transportation network, comprising:
 - storing, in an electronic database, ***a first address and a first functional property code*** associated with a first point to be routed;
 - storing, in the electronic database, a second functional property code, a second address, and a third address associated with a second point;
 - determining in an electronic processing environment if the first address is compatible with the second address;
 - determining in the electronic processing environment if the first functional property code is compatible with the second functional property code if the first address is compatible with the associated second address;***
 - sending the third address to the first point if the first functional property code is compatible with the second functional property code; and
 - at least one of routing an object to the second point based on the third address and retrieving an object from the second point based on the third address.

Applicant respectfully reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."² In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."³ Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁴

Using the preceding well-settled jurisprudence, it is clear that *Kanevsky* fails to anticipate Independent Claim 1. There are two significant issues associated with *Kanevsky* that preclude it from being used as a §102 rejection. First, *Kanevsky* fails to teach, suggest, or disclose ***a first address and a first functional property code***, as is outlined by Independent Claim 1. Second, *Kanevsky* fails to offer any operation associated with *determining in the*

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

² *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

³ MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

⁴ MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

electronic processing environment if the first functional property code is compatible with the second functional property code if the first address is compatible with the associated second address.

With regard to the first missing limitation, there appears to some confusion as to what a functional property code entails. At the point of *Kanevsky* cited by the Examiner, Figure 1 illustrates a post office 14, which purportedly includes a name and post address of the sender. This is simply not a functional property code. In the case of the pending subject matter, an origination point in a network and a tentative destination point may, in general, have both a network address and one or more functional property (FP) codes. An FP code is distinct from an address; these two items are not analogous. For example, an address would typically be used as the index to find a data record related to that particular address. The data record can contain FP codes, but does not necessarily contain any addresses.

Consider another example that further elucidates this distinction. A data record for a particular address may contain a code indicating that the address is a small appliance repair location, or that this location does (or does not) *accept* certain specific hazardous or dangerous materials. Another data record for another network point (a point used for originating shipments in this example) may have a code in its data record indicating that it *sends* small appliances to be repaired. These appliances (in this example) also contain a hazardous material (e.g. PCB liquid coolant), whereby an appropriate FP code could be used to be indicative of this condition. If all shipments from this origin location contain PCB, then the PCB indicating FP code is pre-set permanently in that data record. If only an occasional specific shipment contains PCB, then the appropriate code indicating that PCB is present is entered (or selected) by the originator when performing steps associated with shipping or sending that one particular item and, hence, is not saved permanently.

As an aside, it should also be noted that (in the context of a preferred embodiment) the address is typically the index or look-up parameter in the database and the FP code(s) are the data contents of a data record. It is possible, but not necessary in a preferred embodiment of the invention, to use a separate data record for each FP code and list therein all the addresses that have this FP parameter. This is not necessarily preferred because it requires more data storage space and also takes longer to search in the usual application of the database where the query to be resolved relates to identifying all the FP properties of a

particular address. A person may seek to configure such an arrangement due to a pre-existing database structure.

Note that when a data record (as outlined by the pending claims) contains an address [or a pointer to an address], it is not there for a comparison is to be done between an FP code and an address. FP codes are only compared to other FP codes. Those addresses that are present in the database are there because they may eventually be used as a substitute destination address.

For at least the reason that *Kanevsky* fails to offer such operations associated with FP codes, Independent Claim 1 is clearly patentable over *Kanevsky*. Additionally, Independent Claims 39, 77, 101, 128, and 155 recite a similar limitation and are, therefore, also allowable for analogous reasons. In addition, their dependent claims are also patentable over *Kanevsky* using a similar rationale.

Note that the above-iterated reasons are so substantial that additional discussions that detail why the pending claims are allowable over *Kanevsky* are unnecessary. However, in order to unquestionably demonstrate the allowability of the pending claims, Applicant proffers the following additional arguments for the convenience of the Examiner.

With regard to the second missing limitation, Independent Claim 1 also recites an ability to determine in the electronic processing environment if the first functional property code is compatible with the second functional property code if the first address is compatible with the associated second address. For this teaching, the Examiner again relies on *Kanevsky*: particularly at Column 2: lines 21-59 and Column 4: lines 11-27 of *Kanevsky*. In this case, the Examiner has made an honest mistake in erroneously equating two different and distinct elements: 1) *Kanevsky*'s comparison of two addresses (an e-mail address with a physical delivery address), two addresses that are incompatible for reasons of transmission and delivery method; and 2) in the context of the subject matter of Independent Claim 1, the comparison of the functional purpose codes from the relevant data records of two addresses (network points) to determine if they both have any FP code(s) in common, or to the contrary, if they have two directly conflicting FP codes. Hence, in contrast to the operations circumscribed by Independent Claim 1, *Kanevsky* does not evaluate the compatibility or the incompatibility of FP codes. Indeed, there are no operations described in *Kanevsky* that even relate to the use of FP codes.

The Examiner incorrectly infers that when a specific tentative address is invalid, this situation reflects an instance of what the present application calls “incompatible.” This is incorrect. In the context of the pending subject matter, an originating and destination point can *both* be “valid” (each one corresponding to a deliverable destination), yet they can be incompatible due to a mismatch of their respective FP codes. Incompatibility is a mutual property of the origin and destination. It is not a unilateral property of the destination alone.

Presumably the Examiner has interpreted certain process steps, such as verifying that a particular tentative address is contained in a list of valid addresses, as being the same as the novel process step in the present application: namely the step of comparing the two lists of FP codes of the originator and destination respectively to determine if there are or there are not codes that match in the two lists. This reasoning is simply flawed and untenable.

Note that when a user at an origination point in the transportation network enters (or selects) a tentative or partial destination address (like a corporate name, for example), the control processor gets the FP codes related to the origin and to the tentative destination. The processor then compares the FP codes (*not* the addresses) of the origin and destination. In some cases, there is no incompatibility. For example, the origin can be sending a small appliance for repair and the destination is a small appliance repair location. The tentative destination address is replaced by a specific address for the repair location of that corporation.

In other instances, the processor can uncover an incompatibility. This is discovered because there are conflicts between one or more of the FP codes of the origin (and thus the article being shipped) and what the destination will accept. For example, one of the origin codes indicates that the sender is shipping a particular material that is identifiable as hazardous. Concurrently, the tentative destination has an FP code indicating that it does not accept that particular hazardous material. This is an example of an incompatible origin and destination of the present invention.

In summation, the three main references cited by the Examiner (i.e. *Kanevsky*, *Reilly*, and *Fuisz*) all disclose the use of addresses and *only* addresses. Each of these references fail to offer any usage of FP codes, which are fundamental to the teachings of the present invention. Moreover, there is no instance in any of these cited patents in which FP codes are stored in a database or used in any way as circumscribed by Independent Claim 1. In these

cited references, the choices of which destination address to use for a particular shipment is not made based on a comparison of FP codes of the origin and destination data records.

For all of the reasons outlined above, Independent Claim 1 is again patentable over *Kanevsky*. Independent Claims 39, 101, 128, and 155 include a similar limitation and, therefore, are also allowable over this reference using analogous reasoning. Notice to this effect is respectfully requested.

Section 103 Rejection

The Examiner rejects Claims 18, 21-22, 50, 56, 59-60, 90-93, 95-96, 110-111, and 137-138 under 35 U.S.C. §103(a) as being unpatentable over *Kanevsky* in view of U.S. Patent No. 6,427,164 issued to Reilly (hereinafter "*Reilly*"). The Examiner rejects Claims 23-24, 28-29, 31-32, 36-37, 61-62, 64-67, 69-70, 72-75, 97-99, 112-113, 117-118, 120-121, 123-126, 139-140, 142-145, 147-148, and 150-153 under 35 U.S.C. §103(a) as being unpatentable over *Kanevsky* in view of U.S. Patent No. 6,389,455 issued to Fuisz (hereinafter "*Fuisz*").

With respect to the third criterion of non-obviousness, the Examiner has not shown how the proposed combination teaches each and every limitation of the claimed invention. This has been evaluated thoroughly by Applicant in the tendered §102 analysis: provided *supra*. With no other supporting references that are combinable with *Kanevsky*, all of the claim limitations have not been taught or suggested by the Examiner's currently proposed combinations. Therefore, Applicant respectfully submits that claims 1-168 are patentably distinct from the proposed combinations.

All of the pending claims have been shown to be allowable, as they are patentable over all of the references of record. Notice to this effect is respectfully requested in the form of a full allowance of claims 1-168.

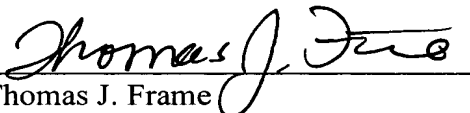
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

Applicant believes no fees are due. If this is not correct, the Commissioner is hereby authorized to charge additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker & Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas J. Frame at 214.953.6675.

Respectfully submitted,
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